

## REMARKS

Claims 1, 3, and 82 have been examined and are now pending in the application. Reexamination and reconsideration of all outstanding rejections and objections are requested.

Claims 1 and 82 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,368,392 (Hollander) in view of the art disclosed by Teledyne Brown Engineering, "Diffractive-Optic Gratings", Photonics Spectra, September 1994, page 186 [hereinafter "Teledyne"].

Claim 1 has previously been rejected solely over the reference Hollander. In the opinion of the Board (Opinion) it is stated that the feature of the claim in dispute, i.e., not disclosed in Hollander, is "a laser aligned to illuminate a diffractive optical system to produce a diffraction pattern in the form of light intensity distribution" for the purposes of identifying and outlining the position and size of the measurement spot on the object of measurement by means of visible light. (Opinion, page 3)

The Board further states that from its study of Hollander there is no teaching or suggestion within Hollander of utilizing a diffractive optical system to produce a diffractive pattern forming light intensity distributions. (Opinion pg. 4).

In the present Office Action is acknowledged that Hollander does not disclose the optical element of the sighting arrangement being a diffractive optical system. It is then stated that Teledyne discloses a holographic element (diffractive optical element) that splits a laser beam into a plurality of laser spots producing a laser pattern of more than two beams.

It is then concluded that it would have been obvious to modify the sighting arrangement disclosed by Hollander by replacing the optical element and motor of the sighting arrangement with a holographic element, as taught by Teledyne, to form the circular light pattern in order to simplify the sighting arrangement by reducing the number of individual working parts.

This rejection is respectfully traversed for the following reasons. In its reversal of the rejection over Hollander the Board stated:

There is no evidence before us, in the form of at least one additional prior art reference, to convince us that the artisan would have found it obvious to have utilized a diffractive optical system to produce the claimed diffraction pattern, even if we agree with the

examiner's views in the answer that diffractive optical systems were known in the art. The question remains, why would the artisan have chosen to use a diffractive optical system instead of or with the seven embodiments in Hollander without additional evidence to persuade the artisan to do so. [emphasis added] (Opinion, page 5)

Note that the Board does not base its reversal on the lack of a showing that diffractive elements exist. Rather, the reversal is based on the lack of a showing of a reason why the artisan would have ignored the teachings of Hollander and would have chosen to use a diffractive optical element instead.

The reasoning of the present Office Action is that the artisan would have chosen to use the diffractive optical element because it would have reduced the number of individual mechanical working parts.

To establish a *prima facie* case of obviousness the prior art must suggest the desirability of the claimed invention. MPEP§2143.01 I.

In this case, although reduction of mechanical parts could be a design goal it most likely would be part of an overall design goal of reducing complexity of manufacture and cost. Depending on other factors such as cost of the grating itself, requirements of the laser needed to make the grating operational, manufacturing costs relating to alignment of the grating and calibration the overall complexity of design and cost of the device could be increased.

Accordingly, the cited art does not answer the question posed by the Board:

The question remains why would the artisan  
have chosen to use a diffractive optical system instead of or  
with the seven embodiments in Hollander without additional  
evidence to persuade the artisan to do so.

In view of the above, a *prima facie* case of obviousness has not been established because the prior art does not suggest the desirability of the claimed invention.

Claims 3 and 82 are allowable for the same reasons as claim 1.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (925) 944-3320.

Respectfully submitted,

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